

## **REMARKS**

### **Status of Claims**

Claims 5 – 9, 11, 12 and 17 are pending in the subject application.

Claims 1 – 4, 10 and 13 – 16 have been canceled.

Allowable claims 8 and 17 have re-written in independent form.

Claims 5, 11 and 12 have been amended to change their dependencies to allowable claim 8.

Claims 6 and 7 remain dependent from claim 5.

Claim 9 remains dependent from claim 8.

### **Improper Finality of Office Action**

As an initial matter, the finality of the present Office action is improper under the requirements set forth in MPEP § 706.07. As such, Applicant respectfully requests the finality of the Office action be withdrawn. MPEP § 706.07(a) states that “second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)” (emphasis added). Stated another way, where an Office action introduces a new ground of rejection to a claim that has not been amended, it is improper for that action to be made final.

In the Amendment filed 24 July 2009 in response to the prior office action, Applicant made no substantive amendment to claim 4 which was merely re-written in independent form. In fact, in the Remarks accompanying that amendment, Applicant explicitly stated:

“Claim 4 remains unchanged except for being converted from dependent to independent form. In other words, this claim is a combination of original claims 1, 2, 3 and 4. Because of this, any new grounds for rejection raised against this claim should not be made Final.”

In the present Office action mailed 08 October 2009, new grounds of rejection of claims 1 – 5, and particularly of claim 4, have been introduced. Specifically, the Office action rejected claims 1 - 5 under 35 U.S.C. § 102(b) as being anticipated by Snow (3204347), and rejected claims 1 - 5 under 35 U.S.C. § 103(a) as unpatentable over Heller (6301806) in view of Snow.

Since the present office action applied new grounds of rejection, and since the action was made final, the pertinent question is whether these new grounds of rejection were necessitated by claim amendments made by Applicant. As noted above, Applicant made no substantive amendments to claim 4 in the Amendment filed 24 April 2009. In addition, no new information disclosure statement was filed. Accordingly, the new grounds of rejection could not have been necessitated by claim amendments. Consequently, the finality of the Office action mailed 08 October 2009 is improper and must be withdrawn.

Note that the foregoing requirement (i.e., “necessitated by amendment”) for making an Office action final is the only test set forth in the MPEP for determining whether the finality of an Office action is proper under these circumstances. Thus, the fact that Applicant added claims in the Response filed 24 April 2009 is not relevant to the issue of whether or not the present office action has been improperly made final. The issue is whether or not new grounds of rejection were applied to any claims that were not amended.

For the foregoing reasons, the finality holding of the office action mailed on 08 October 2009 is premature, and Applicant respectfully requests the finality of the rejection be withdrawn. Moreover, since the Office Action should have been non-final, the Examiner should now properly enter and consider the amendments submitted in the present Amendment.

This latter point may ultimately be moot since all of the claims remaining in the application have either been indicated as allowable or depend from a claim that has been so indicated.

#### The Rejected Claims

Rejected claims 1 – 4, 10 and 13 - 16 have been canceled.

Rejected claims 5, 11 and 12 now depend from allowable claim 8 and are patentable therewith.

Rejected claims 6 and 7 remain dependent from claim 5 which, because of its dependency from allowable claim 8 is patentable. Accordingly, claims 6 and 7 are patentable.

Conclusion

In view of the remarks set forth above it is submitted that this application, with claims 5 – 9, 11, 12 and 17, is in condition for allowance. However, if for any reason the Examiner believes that the application is not now in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney to discuss any unresolved issues and expedite the disposition of the application.

Applicant hereby petitions for any extension of time that may be necessary to maintain the pendency of this application. The Commissioner is hereby authorized to charge payment of any additional fees required for the above-identified application or credit any overpayment to Deposit Account No. 05-0460.

Respectfully submitted,

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